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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Schlutz & Associates, P.C.
5400 LBJ Freeway
Dallas, TX 75240

EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/734,461	Applicant(s) PEMBERTON ET AL.	
	Examiner Mark A. Osele	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-15, 42-45 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 42-45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION


In view of the appeal brief filed on March 19, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
AU 1734

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Hoogstoel et al. (U.S. Patent 2,744,624). Hoogstoel et al. shows an article comprising a substantially rigid (column 2, lines 39-44) corrugated substrate, 22; a strip, 21, having a first adhesive surface and a second adhesive surface, the strip releasably adhered to the corrugated substrate on the first adhesive surface; and a release layer, 20, adhered on the second adhesive surface (Fig. 4; column 4, lines 33-51).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straub (U.S. Patent 4,824,702) in view of Ferraro (U.S. Patent 4,511,608), Kriozere (U.S. Patent 4,348,440), and Ittershagen et al. (U.S. Patent 5,168,831). Straub shows a plurality of continuous, unperforated double sided adhesive elements, 13, releasably adhered to and arranged side-by-side on a planar, unperforated transfer sheet, 16, and

a plurality of continuous unperforated release layers, 15, each of the release layers releasably adhered on the second adhesive surface of the strips (Fig. 1), wherein the strips are adapted to be removed from the transfer sheet and releasably adhered to an article on the first adhesive surface and the release layers are adapted to be removed from the second adhesive surface revealing the second adhesive surface. The adhesive of Straub is shown to be sufficient to hold an artificial fingernail to a finger and this tack strength would be sufficient to cause a sticking sensation. Straub fails to show the release layers bisected and the same length as each of the strips.

Ferraro also shows a plurality of continuous, unperforated double sided adhesive elements, 5, releasably adhered to and arranged side-by-side on a planar, transfer sheet, 21, and a plurality of continuous unperforated release layers, 9, each of the release layers releasably adhered on the second adhesive surface of the strips and bisected at 19. Ferraro shows that release layers substantially the same length as each of the strips and including a bisecting cut, 19, is an alternative means for applying a double sided adhesive tape to a substrate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the equivalent length, bisected release layers of Ferraro in the article of Straub because they are shown to be functionally equivalent alternate expedients.

Kriozere shows that the backing sheet, 16, 18, of a rectangular adhesive element, 12, is slit along the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires

alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of the references as combined above because Kriozere shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

Ittershagen et al. teaches that one use for double sided adhesive tapes is to prevent an animal from touching an undesired region. This is accomplished by making the adhesive layers transparent (column 3, lines 1-6, 10-13, 62-68) and making the top adhesive of a tack strength sufficient to cause a releasable sticking sensation to the animal (column 1, lines 17-20; column 3, lines 21-30) and the bottom adhesive layer capable of being releasably adhered to home furnishings (column 2, lines 14-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive element of the references as combined above transparent and with tack strength to releasably adhere to an animal because Ittershagen et al. teaches the benefits of these adhesive materials in preventing an animal from touching undesired regions.

Regarding claims 2 and 3, Straub shows the strips are uniformly spaced apart from one another by gaps on the transfer sheet that are parallel to the length of the strips and are of a width that is equal to a substantial fraction of the width of the strips to provide an indication of an edge of the plurality of the strips.

5. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel et al. (U.S. Patent 2,744,624). As shown in paragraph 2 above, Hoogstoel et al. shows the instantly claimed product except for the material of the substrate. Hoogstoel et al. teaches that the substrate can comprise any desired material flexible or rigid material (column 2, lines 30-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the substrate of Hoogstoel et al. of plastic because plastic is an inexpensive, conventional material for corrugated materials.

Regarding claim 44, Hoogstoel et al. shows the substrate to be made of a material such as kraft paper, which is the color of many soils. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use kraft paper or a similarly colored plastic as the substrate because Hoogstoel et al. shows substrates of this color to be acceptable for adhesive coated, corrugated articles.

6. Claims 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel et al. in view of Bode and Kriozere. As shown in paragraph 2 above, Hoogstoel et al. shows the instantly claimed product except for the release layer to comprise two separately removable portions. Bode shows that it is helpful to provide a slit, 16, along the centerline of an unperforated backing sheet, 10, on an adhesive element, 11, 12, 13, so that the edges of the element are not damaged by force required on the edge when removing a backing sheet without a slit (Page 1, right column, lines 40-55). Kriozere shows that the backing sheet, 16, 18, of a rectangular

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adhesive element, 12, is slit along the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of Hoogstoel et al. because Bode teaches this location for a slit prevents damage to the peripheral edges and Kriozere shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

Regarding claim 47, Hoogstoel et al. shows a plurality of adhesive strips, 21, placed side-by-side on the corrugated substrate, 22, separated by a gap having a width which is a substantial fraction of the width of the strips (Fig. 4).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not include

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the newly claimed subject matter that a plurality of strips are placed side by side on a corrugated substrate separated by a gap having a width which is a substantial fraction of the width of the strips. The two full paragraphs of page 6 of the instant specification and Fig. 4 of the instant application each show a corrugated substrate with only one strip of adhesive, not a plurality placed side by side. Regarding claim 45, although Fig. 4 shows the release layer to comprise two separately removable portions, there is no description that the two removable portions abut but do not overlap a central longitudinal axis of the strip.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 8 includes the limitation that the release layers are "unperforated" but line 9 has the contradictory limitation that the release layers are "completely bisected." It is unclear whether the invention is being limited to unperforated release layers or release layers with a bisecting cut.

Response to Arguments

11. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, the examiner fully replied to the evidence of secondary considerations in the office action of September 25, 2006.

Applicant has included new arguments against the rejections to claims 42-45 and 47. First addressing applicant's arguments that the disclosure supports claims 45 and 47, applicant points to portions of the written specification which are directed to the embodiment of Figure 1 as support for limitations now claimed as being part of the embodiment of Figures 4 and 5. There is no reason for one of ordinary skill in the art to understand or assume that these limitations specifically directed to Figure 1 would also be directed to the embodiment of Figures 4 and 5 which have a very different purpose. In the embodiment of Figure 1, a plurality of double sided adhesive strips are peeled from a backing sheet and applied individually to an article of furniture followed by peeling off a release cover sheet. In the embodiment of Figures 4 and 5, individual strips of adhesive are supplied on a corrugated backing with a release cover sheet. The release cover sheet is peeled off each adhesive and the corrugated backing with the exposed adhesive is placed inside a potted plant. The adhesive is never peeled from the corrugated backing and one of ordinary skill in the art would not think to place a plurality of adhesive strips on the corrugated backing.

Next addressing applicant's argument that Hoogstoel does not disclose a sheet with adhesive on opposing sides adhered to a corrugated substrate and a release layer, it is reiterated that claim 42 is directed toward the embodiment of Figures 4 and 5, not Figure 1. In the embodiment of Figure 4, a corrugated substrate, 43, is coated with an adhesive layer, 45, and covered by a release layer, 47. This is exactly the makeup of the invention of Hoogstoel. The instant specification does not describe *a sheet with adhesive on opposing sides* adhered to a corrugated substrate, nor is this claimed.

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What is claimed in claim 42 is "a strip having a first adhesive surface and a second adhesive surface." When interpreted broadly, the embodiment of Figure 4 shows a strip, 45, with a first adhesive surface in contact with the corrugated substrate, 43, and a second adhesive surface in contact with the release layer, 47. Again, this is the same broad interpretation of the claim used when considering the Hoogstoel reference. Applicant's arguments are neither commensurate in scope with applicant's claims nor invention.

Conclusion

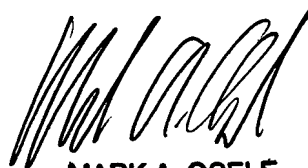
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Donahue and Pomerantz, which are not prior art against the instant invention, McMaster and Carpenter each show double sided adhesive tabs. Sorrell shows a double sided tape on a corrugated release material (Fig. 3).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE
PRIMARY EXAMINER

May 17, 2007